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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,013	03/31/2004	Odile Aubrun-Sonneville	238320US0	5266
22850 7590 10/07/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER VENKAT, JYOTHSNA A				
ART UNIT		PAPER NUMBER		
1619				
NOTIFICATION DATE		DELIVERY MODE		
10/07/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/813,013

**Applicant(s)**

AUBRUN-SONNEVILLE ET AL.

**Examiner**

JYOTHSNA A. VENKAT

**Art Unit**

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-10 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-10 and 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF008)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/9/09 has been entered.

### **Status of claims**

**Claim 2 is cancelled** and claims 11-12 are withdrawn from consideration as being drawn to non-elected invention (**Election without traverse**). Claims 1, 3-10 and 13-20 are currently examined in the application.

In view of amendment dated 9/9/09 which recites specific lipophilic emulsifiers, rejection of claims 1, 3-10 and 13-20 under 102 (e) over patent 6,645,476 is hereby withdrawn.

### ***Claim Rejections - 35 USC § 112***

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 lacks antecedent basis since in claim 1 *p* is zero.

### ***Claim Rejections - 35 USC § 103***

Claims 1, 3-10 and 13-20 are rejected under 35 U.S.C. 103 as being obvious over U.S. Patent No. 6,645,476 ('476).

Patent '476, discloses a water-soluble co-polymer for use in cosmetic compositions, wherein the co-polymer contains a macro- monomer having a hydrophobic moiety and one or more olefinically unsaturated co- monomers which contain a sulfur atom (see abstract and col. 2, lines 18-28). Patent discloses that the co-polymers have a number molecular weight of 1,000-1, 5000,000 g/mol (see col. 4, lines 1-15). See col. 3 paragraphs 1-5, compositions comprising a copolymer wherein one monomer is acrylamidopropylmethylenesulfonic acid (AMPS) or its salts and one or more macro monomers including esters of methacrylic acid with alkyl ethoxylates which include 5 to 80 ethylene oxide (EO) units and/or (C10-C22)-alkyl radicals. In col. 2 lines 50-65 patent discloses a series of olefinically unsaturated monomers. Patent discloses at col. 11, Example 2, a general polymerization procedure wherein NH<sub>3</sub>-neutralized AMPS, Genapol U-080 containing 10-1.8 carbon fatty alcohol polyglycol ethers with 8 EO units, a macro monomer, t-butanol and AIBN are reacted. Further patent discloses at col. 3 paragraphs 1 and 2 that the degree of neutralization is preferably between 70-100% meeting the partially neutralized form or a totally neutralized. At col. 4 paragraph 2, patent teaches that the polymers have a number-average MW of from 1000-20,000,000 g/mol, preferably 20,000 to 5,000,000, particularly preferably 100,000 to 1,500,000 g/mol. In col. 4, paragraph 7, patent discloses that the viscosities of the 1% strength aqueous solutions are preferably from 20,000 mPas to 100,000 mPas, in particular 60,000 mPas to 70,000 mPas. Patent discloses in col. 4 paragraphs 8 and 9 that the polymers are prepared by free-radical copolymerization with preference given to precipitation polymerization with tert-butanol. Patent discloses in col. 2 under example B olefinically unsaturated comonomers and at Col. 4 paragraph 3 teaches that in a preferred embodiment the polymers are cross linked, i.e. they contain at least one cross linker having at

least two double bonds, which is copolymerized into the polymer. In col. 2, patent discloses preferred embodiments A and B and details macro monomers. Patent discloses at col. 4 paragraph 2 that the polymers can be random and in col. 3 paragraph 1 and 2 that the olefinically unsaturated acids of the polymers can be neutralized by monoalkylammonium, dialkylammonium, trialkylammonium, or tetraalkylammonium where the alkyl substituents of the ammonium ions are (C1-C22)-alkyl radicals. The monomer as presented in formula (I) of the application is disclosed by patent at col. 2, lines 25-50.

Patent at col. 3, ll 35-60 discloses suitable macro monomers and at lines 60-64 discloses using iso-(C16-C18) fatty alcohol polyglycol ethers with 25 EO units. The preferred macromer under A of patent is from ll 37-59 and **see especially the macromer Genapol LA70 (claimed instant application as formula II)** and this macromer is tested in the declaration see same column, ll 60-65 for the preferred comonomer, **which is AMPS. AMPS claimed in instant application as formula I.** The molar proportion of monomer units are anticipated by patent at col. 3 line 65 and col. 4 line 8. Patent discloses 0.5% by weight of amphiphilic copolymer in example 42. Patent discloses in example 43 an O/W after sun milk composition, in example 45 a W/O cream, in example 46 a body wash, in example 47 a baby shampoo, in example 48 an antidandruff shampoo, and in example 50 a hair gel.

Patent discloses that the co-polymers are used in combination with anionic, nonionic, cationic, zwitterionic and amphoteric surfactants to form cosmetic compositions (see col. 6, line 8-col. 7, and line 54). Patent at col.9, ll 49-63 discloses co-emulsifiers and this includes sorbitan esters, glycerol esters, and polyglycerol esters. The first 4 co-emulsifiers are within the esters taught by patent. These compounds read on claimed lipophilic emulsifier. Examples 41-51,

disclose formulation compositions that contain the water-soluble co-polymer in combination with various surfactants, water and solvents. See col.9, lines 10-14 for emulsions. This includes claimed oil-in-water emulsions (O/W). Examples 41-43 are drawn to O/W emulsions.

One of ordinary skill in the art would prepare the compositions in the form of oil-in-water emulsions using the amphiphilic polymer and one lipophilic emulsifier and use it for topical application taught by patent '476.

### ***Response to Arguments***

Applicant's arguments filed 9/9/09 have been fully considered but they are not persuasive.

Applicants' argue that the results in the specification and the two examples in the declaration are sufficient to overcome the 103 rejection.

In response to the above argument, the test results in the specification and declaration are not commensurate with the scope of claims. Applicants' have not addressed first two items. See below for the reasons stated in final rejection.

1. One compound belonging to amphiphilic polymer was tested. What is the mole percent of AMPS (this belongs to component (A))? Claim 1 recites the mole percent of AMPS as 80 mol % to 99 mol%. Example A in the declaration is silent with respect to mole percent of AMPS.

2. Genapol LA-070 belonging to component (B) was tested. **What is R2, n in Genapol LA-070?**

3. The lipophilic emulsifiers tested in the declaration were 1) Sucrose tristearate and 2) PEG/PPG/18 dimethicone. Claim 1 recites "dimethicone copolyol". **This compound was not tested either in the specification or declaration.**

4. Lipophilic emulsifiers tested in the specification were 1) glyceryl isostearate in examples 1 and 3 and 2) PEG-8-isostearate.

Claim 1 recites the emulsifiers glyceryl stearate, sorbitan stearate, sorbitan glyceryl stearate, methyl glucose stearate, sucrose stearate and dimethicone copolyols and combinations there of.

4. Declaration did not show results using combination of co-emulsifiers (emulsifiers)

**5. What is the weight percent of the polymer tested in the declaration and specification and what is the weight percent of lipophilic emulsifier?**

The showing in the declaration and specification is not commensurate with the scope of claims since patent teaches all the claimed components. Therefore 103 rejection is deemed proper.

Prosecution can be advance by limiting the claim 1 to that tested in the specification and declaration by reciting the specific mole percent of formula I and II and specific weight percent of amphiphilic polymer and reciting specific lipophilic emulsifiers tested in the specification and declaration and not combinations thereof and reciting the weight percent of amphiphilic polymer and lipophilic emulsifier.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /  
Primary Examiner, Art Unit 1619